

## **REMARKS/ARGUMENTS**

### ***Amendments in General***

1. In Response to the Examiner's requirement, applicant herein submits a new set of drawings wherein the drawings which were previously submitted have been redrawn so as to address the Examiner's requirement. No new matter has been added to the application and acceptance of these drawings as amended is respectfully requested.
2. Claim 22 has been canceled from the application.

### ***Claim Rejections - 35 USC § 102***

3. The Examiner rejected claims 1-3, 5-9, 11-13, 16-18, 20 22 and 23 under 35 USC §102(b) as being anticipated by WO 00/09825.
4. Claim 22 has been canceled from the application, which leaves claims 1 and 23 as the only remaining independent claims in the application.
5. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d. 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 828 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). MPEP § 2131.
6. All of the claims in the application require that the seal included in the invention contain a lip which is arranged so that the sealing face of the lip will inherently roll radially when subject to axial compression, this lip providing a surface profile that is substantially hemicylindrical.
7. The Examiner has indicated that WO 00/09825 includes this feature, and refers to the item described in Fig. 6 of this reference. Applicant respectfully disagrees and brings the following to the Examiner's attention.
8. The item shown in Fig. 6 of the WO 00/09825 reference is not configured so as to allow the lip of the device to roll when subjected to a force. Instead this device is configured to collapse and buckle so as to move the upper disk 52 axially toward the lower disk 54. As is described on page 14 beginning on line 4, ". . .allowing the upper disc member 52 to move towards the lower disc member 54, such that they are compressed together to form a seal between the upper flange portion 10 and the toilet bowl 5".

9. If the device described in the WO 00/09825 reference acted so as to cause the lip to roll inwardly, the desired seal would not be formed. If the upper disc member 52 rolled radially inwards or radially outwards, then the disc member 52 would move the side of the lower disc member 54 and they could not be compressed together to form a seal.
10. As has been discussed previously, the axial movement of the upper disc member 52 toward the lower disc member 54 so as to cause the formation of a seal would not take place if the upper disc member rolled radially inwardly or outwardly. If these upper disc members rolled inwardly or outwardly as is claimed in the present invention, the upper and lower discs would not align and could not be compressed together to form a seal.
11. The present invention however contains a shape, geometry and relative thicknesses which allow the lip to roll outwardly in a predictable manner as is described at page 3 lines 11 to 26 of the application as filed and which is included in the language of claims 1 and 23.
12. In as much as the WO 00/09825 reference fails to teach this feature, the present invention as described in the claims above is not anticipated by this reference.
13. Furthermore, applicant respectfully submits that mere formation of a particular item from a piece of elastomeric material does not inherently teach or signify that the particular piece will have a friction increasing formation or characteristics. Elastomeric materials come in many different varieties and configurations which are adapted to contain a variety of different features and functions. The mere recitation of a device being made from elastomeric material does not without more information, provide any disclosure as to the frictional characteristics of the item.

### ***Claim Rejections - 35 USC § 103***

14. The Examiner rejected claims 14, 15 and 19 under §103(a) as being unpatentable (obvious) in view of WO 00/09825.
15. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” MPEP § 706.02(j).

16. As was discussed previously, the reference cited by the Examiner fails to teach the presence of a lip that is adapted or configured to roll radially when subjected to an axial force. Therefore, a prima facie case of obviousness has not been made, because all of the elements which are present in the claims of the application are not taught.

17. Furthermore, the modifications of the WO 00/09825 reference which are claimed by the Examiner are without suggestion or motivation to do such and are without any reasonable expectation of success.

18. The law regarding obviousness is clear--any modification of the prior art must be suggested or motivated by the prior art. While certain features are shown in the Atkins reference there is no motivation or suggestion in the references themselves which would suggest making the combinations that have been made.

‘Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.’ [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious “modification” of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

*In re Fitch*, 972 F.2d 1260, 23 USPQ2d 1780, 1783-4 (Fed.Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

19. The Examiner must prove motivation to modify the prior art. *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998) (describing “teaching or suggestion or motivation [to combine]” as an “essential evidentiary component of an obviousness holding”), see also *In re Rouffet*, 149 F.3d 1350, 1359 (Fed. Cir. 1998) (“the Board must identify specifically...the reasons one or ordinary skill in the art would have been motivated to select the references and combine them”).

20. This objective evidence must provide motivation to modify the prior art.

We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although “the suggestion more often comes from the teachings of the pertinent references ...” The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. Broad conclusionary statements regarding the teaching of multiple references, standing alone, are not “evidence.”

*In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

21. There is no motivation or suggestion in the Atkins reference itself to make the modifications which are present in the claims of the currently pending application, nor has the Examiner provided any other evidence of such. Without these express suggestions, Applicant respectfully submits that a prima facie case of obviousness has not been made, and asks the Examiner withdraw his/her rejection.

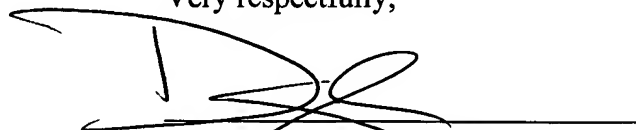
### CONCLUSION

Entrance of these amendments and consideration and allowance of the application as amended is respectfully requested.

If the Examiner has any questions in regard to this response they are invited to phone the undersigned below.

DATED this 28<sup>th</sup> day of February, 2006

Very respectfully,



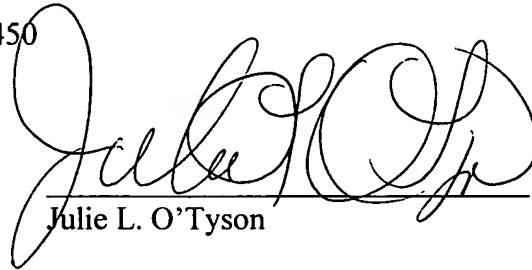
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CERTIFICATE OF MAILING

I HEREBY CERTIFY that this correspondence is being deposited with the United States Postal Service on the below date as first class mail in an envelope addressed to:

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DATE: February 28, 2006



Julie L. O'Tyson

## **AMENDMENTS**

### **Amendments to the Drawings:**

The attached sheet of drawings includes changes to Figs. 1-3. This sheet, which includes Figs. 1-3, replaces the original sheet including Figs. 1-3.

The attached sheet of drawings includes changes to Figs. 4-5. This sheet, which includes Figs. 4-5, replaces the original sheets including Figs. 4-5.

The attached sheet of drawings includes changes to Figs. 6-7. This sheet, which includes Figs. 6-7, replaces the original sheet including Figs. 6-7.

Attachment: Replacement Sheets